



DAC *P*

Attorney Docket No. 53800.930CIP *HS*

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re the Application of)
SAITO, Makoto)
Serial No.: 08/846,661) Examiner:
(CIP of 08/549,271 filed 10/27/95 &) Group Art Unit: 2202
08/733,504 filed 10/18/96)
Filing Date: May 1, 1997 (Disputed))
For: DATA MANAGEMENT)
SYSTEM)

PETITION TO CORRECT FILING DATE AS THE DATE OF DEPOSIT
AS "EXPRESS MAIL" PURSUANT TO 37 C.F.R. §1.181 SUBMITTED IN
ACCORDANCE WITH THE PROVISIONS OF C.F.R. §1.10(c) AND §1.53(b)

Assistant Commissioner of Patents
BOX DAC
Office of Petitions
Washington, D.C. 20231

Sir:

This is a petition to establish the filing date for the above-referenced patent application as April 29, 1997 (the date upon which the application was deposited with sufficient postage to the United States Post Office utilizing the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS), and the date indicated as "date-in" on the Express Mail mailing label receipt).

01/02/1998 KMARLMS 00000084 08846661
01 FC:122 130.00 *mm* This petition is submitted in accordance with the provisions of 37 C.F.R. § 1.10(c) and 37 C.F.R. § 1.53(b). The petition is submitted pursuant to 37 C.F.R. § 1.181 together with the required petition fee of \$130.00 pursuant to 37 C.F.R. § 1.17(i). The Commissioner is hereby authorized to charge payment of any additional fees

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THE DATE OF DEPOSIT AS "EXPRESS MAIL"
VIA EXPRESS MAIL LABEL NO. EM450816336US

associated with this petition or credit any over payment to Hecker & Harriman Account Number 08-1520. A copy of this Petition indicating this authorization is enclosed for this purpose. Nevertheless, because the application was accorded an incorrect filing date by an error made on behalf of the United States Patent and Trademark Office, and through no fault of the Applicant, Applicant respectfully requests that the Commissioner refund the \$130.00 petition fee once this petition is granted.

FACTS

1. Applicant's counsel prepared the above-identified patent application for filing with the United States Patent and Trademark Office. The patent application package contained the following items:

- (a) An original and one copy of the transmittal letter with a Certificate of Mailing by Express Mail dated April 29, 1997 and with Express Mail Label No. EM100740755US indicated thereon;
- (b) A seventy-two page patent specification entitled "Data Management System" with Express Mail Label No. EM100740755US indicated on each page thereof together with six (6) pages of informal drawings (hereinafter referred to as the "Application Papers"); and
- (c) A return receipt postcard identifying each of the above items.

A copy of the above items are attached as Exhibit 1 to the Declaration of Lillian E. Rodriguez submitted concurrently herewith.

2. The application was applied for in the name of the actual inventor pursuant to 37 C. F. R. § 1.41(a). (Rodriguez Declaration, Exhibit 1.) The application included a specification containing a description of the invention, four (4) claims, and six (6) sheets of informal drawings. (Rodriguez Declaration, Exhibit 1.) The application also contained the Express Mail number in the footer of each page of the patent application specification and claims (i.e. pp. 2-72 (Rodriguez Declaration, Exhibit 1.)).

3. On April 29, 1997, under the direction of the Applicant's counsel, counsel's secretary prepared an Express Mail mailing label bearing the number EM100740755US addressed to the Commissioner of Patents and Trademarks, Washington, D. C. 20231. The Express Mail mailing label (EM100740755US) was affixed to an Express Mail envelope and the label listed Hecker & Harriman's corporate account number to ensure the proper amount of postage for its timely delivery. (Rodriguez Declaration ¶ 2.) A true and correct copy of the Express Mail mailing label (EM100740755US) is attached to the Rodriguez Declaration as Exhibit 2.

4. On April 29, 1997, under the direction of the Applicant's counsel, counsel's secretary affixed certificates of mailing by Express Mail on the transmittal letter and on the title page, abstract and last page of drawings of the Application Papers. These certificates stated:

"I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail (Label No. EM100740755US) in an envelope addressed to "Commissioner of Patents and Trademarks, Washington, D. C. 20231, on April 29, 1997 (Date of Deposit)." (Rodriguez Declaration, Exhibit 1.)

This certificate was signed by counsel's secretary, Lillian E. Rodriguez, on April 29, 1997. (Rodriguez Declaration ¶ 3.)

5. On April 29, 1997 counsel's secretary placed and sealed all above-identified contents of the patent application into an Express Mail envelope bearing the Express Mail mailing label number EM100740755US. (Rodriguez Declaration ¶ 4.)

6. On April 29, 1997 counsel's secretary personally caused the sealed Express Mail envelope bearing the Express Mail mailing label number EM100740755US and containing the Application Papers to be deposited with the Express Mail United States Postal Depository at the Los Angeles International Airport. (Rodriguez Declaration ¶ 5.)

7. As indicated by the date specified in the "Date In" box of the Express Mail receipt, the Express Mail envelope bearing the Express Mail mailing label number EM100740755US was deposited with the United States Postal Service on April 29, 1997. A true and correct copy of the Express Mail receipt for Express Mail mailing label number EM100740755US indicating the "Date In" of 4/29/97 is attached to the Rodriguez Declaration as Exhibit 3.

8. On September 8, 1997 the official Filing Receipt for the patent application indicating an incorrect filing date of "05/01/97" was received by Applicant's counsel. A true and correct copy of the Filing Receipt is attached to the Rodriguez Declaration as Exhibit 4.

9. Contrary to the filing date accorded by the Patent and Trademark Office as "05/01/97," the correct filing date of Application Serial No. 08/846,661 is April 29, 1997.

10. 37 C.F.R. § 1.53(b) states as follows:

"[t]he filing date of an Application for patent filed under this section is the date on which: (1) A specification containing a description pursuant to §1.71 and at least one claim pursuant to §1.75; and (2) any drawing required by §1.81(a), are filed in the Patent and Trademark Office in the name of the actual inventor or inventors as required by §1.41."

11. 37 C.F.R. §1.10(a) states as follows:

"[a]ny correspondence ... received by the Patent and Trademark Office (Office) ' that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered as filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date in" on the "Express Mail" mailing label or other official USPS notation...."
(emphasis added)

12. In accordance with the provisions of 37 C.F.R. §1.53(b) and 37 C.F.R. §1.10(a) and §1.10(c), Applicant submits that:

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- (a) There is a discrepancy between the filing date accorded by the Patent and Trademark Office to the application and the date of deposit as shown by the "date-in" on the "Express Mail" mailing label;
- (b) This petition is being filed promptly after Applicant has become aware that the Patent and Trademark Office has accorded an incorrect filing date on the application;
- (c) The number of the "Express Mail" mailing label (EM100740755US) was placed on the paper(s) that constitute the patent application (Rodriguez Declaration, Exhibit 1.);
- (d) The "date-in" on "Express Mail" mailing label number EM100740755US correctly reflects the date of the deposit of April 29, 1997 (Rodriguez Declaration, Exhibit 3.);
- (e) The Certificate of Mailing affixed on the above-identified patent application correctly reflects the date of deposit of 4/29/97. (Rodriguez Declaration ¶ 3, Exhibits 1 and 3.); and
- (f) The application was applied for in the name of the actual inventors pursuant to 37 C. F. R. § 1.41(a). (Rodriguez Declaration, Exhibit 1.) Further, the Application Papers include a specification containing a description of the invention, four (4) claims, and six (6) sheets of informal drawings. (Rodriguez Declaration, Exhibit 1.)

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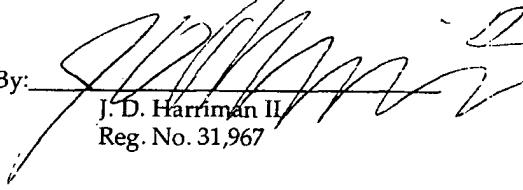
CONCLUSION

Based on the foregoing facts and pursuant to 37 C. F. R. § 1.10(c) and 37 C. F. R. § 1.53, Petitioner respectfully requests that the Application Papers be accorded a filing date of April 29, 1997 which is the actual date of deposit of the Application Papers via "Express Mail Post Office to Addressee" service of the United States Postal Service and the date indicated as "date-in" on the "Express Mail" label number EM100740755US. Applicant also respectfully requests that the \$130.00 petition fee be refunded if the Commissioner grants this petition.

Respectfully submitted,

HECKER & HARRIMAN

Date: 12/2/97

By: 

J. D. Harriman II
Reg. No. 31,967

2029 Century Park East, Suite 1600
Los Angeles, CA 90067
(310) 286-0377

CERTIFICATE OF MAILING

This is to certify that this correspondence is being deposited with the United States Postal Service as EXPRESS MAIL No. EM450816336US in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D. C., 20231 on: December 2, 1997
Marlon I. Maglente 12/2/97
Marlon I. Maglente Date